

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Mason et al.

Group Art Unit: 2416

Serial No.: 09/627,253

Examiner: Nguyen, Toan D.

Filed: July 28, 2000

Docket No. 1322/40/2

Confirmation No.: 2388

For: PRESENCE REGISTRATION AND ROUTING NODE

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PETITION AND RESPONSE TO REQUEST FOR RECALCULATION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants filed a petition in accordance with 37 C.F.R. § 1.705(d) on the patent issue date of April 20, 2010. Applicants respectfully submit that the petition was erroneously treated as a Request for Recalculation of Patent Term Adjustment ("PTA") in view of Wyeth as it was summarily dismissed on April 26, 2010. As such, Applicants are re-filing this petition, and respectfully request a substantive review of the PTA in accordance with the facts set forth herein.

The Patent Application Information Retrieval (PAIR) system indicates the patent term adjustment PTA for this application is 1,635 days. However, Applicants respectfully submit the correct PTA for this application is 1,689 days and request the PTA be adjusted to include the additional 54 days. Applicants respectfully request reconsideration of the PTA for this application under 35 U.S.C. § 154 (b)(3)((B)(ii). Favorable consideration is respectfully requested in view of the following statement of the facts in accordance with 37 C.F.R. § 1.705(b).

STATEMENT OF THE FACTS

Applicants filed utility patent application 09/627,253 on July 28, 2000 claiming priority to a provisional application filed on March 22, 2000. Applications filed on or after May 29, 2000 may have the patent term adjusted due to examination delay under the Patent Term Guarantee Act of 1999. (See 37 C.F.R. § 1.702). Adjustment of patent term is appropriate on two occasions. The first occasion is for the failure of the Office to take certain actions within specified time frames, and the second occasion is for failing to issue a patent within three (3) years of the actual filing date of the application. (See 37 C.F.R. § 1.702(a), (b) and 35 U.S.C. § 154(b)). Adjustments may be reduced by any overlap in credits for the two occasions, and for Applicants' failure to engage in reasonable efforts to conclude prosecution of the application.

Basis for the Correct PTA

The correct PTA for this application is believed to be 1,689 days. This number is calculated by summing a total of 2,458 days of credit for failing to issue a patent within three years of the actual filing date and 420 days of credit for the Office's failure to take certain actions within specified time periods under 37 C.F.R. § 1.702(a). The sum does not include the number of days for any overlap between the 37 C.F.R. § 1.702(a) and (b) time periods. (See 35 U.S.C. § 154(b)(2)(A), and §154(b)(1)(B)). The sum is subject to reduction for 546 days occurring between notice of appeals and re-opening prosecution. (See 37 C.F.R. § 1.703(b)(4)). The sum is further reduced by 643 days in which Applicants' response to actions falls outside of the three month time period. (See 35 U.S.C § 154(b)(2)(C) and 37 C.F.R. § 1.704(a)).

Summary of Dates Used

Dates Used in Calculating PTA Credits

The dates used in Applicants' calculations came from the application transaction history which is available on PAIR. The tables below show the dates used, whether the dates correspond to a debit or a credit in days of PTA, and the basis for the adjustment. The total PTA in days is then calculated from the difference in value between the total credits and total debits available. Each is discussed below.

Applicants are entitled to a total of 2,878 days of PTA credit under the guarantees listed in 35 U.S.C. § 154(b)(1)(A) and (b)(1)(B). This credit is subject to reduction discussed in the next section. The credit associated with adjustment for examination delays is calculated using 37 C.F.R. §§ 1.703(a)(1)-(4) and (b), which allows the term of the patent to be adjusted. Adjustments are proper when the issuance of the patent was delayed due to the failure of the Office to mail at least one notice of rejection or reexamination not later than fourteen (14) months from the date on which the application was filed, for failure of the Office to respond to an Applicant's reply not more than four (4) months after the date on which the reply was filed, and for failing to issue a patent within three (3) years from the date the application was filed.

With respect to 37 C.F.R. § 1.703(b) and 35 U.S.C. § 154(b)(1)(B), an adjustment is proper when a patent fails to issue within three years of the application filing date. The patent was filed on July 28, 2000 and issued on April 20, 2010. The number of days from the three year date of July 28, 2003 to the issue date of April 20, 2010 is 2,458 days, to which Applicants are entitled a credit. This number will be

reduced by 546 days per 37 C.F.R. § 1.703(b)(4) which is discussed under the section discussing dates used in calculating PTA debits.

With respect to 37 C.F.R. § 1.703(a)(1) and 35 U.S.C. § 154(b)(1)(A), the relevant dates are the application filing date (July 28, 2000), fourteen months from the application filing date (September 28, 2001), and the first office action mailing date (November 22, 2002). According to 37 C.F.R. § 1.703(a)(1), the number of days credit allowed for this delay is counted beginning from the day after the date that is fourteen months after the application filing date and ending on the mailing date of the action or notice of allowance, whichever occurs first. The day after fourteen months from the filing date is September 28, 2001, and the first office action was not mailed until November 22, 2002. There are 420 days counted between September 28, 2001 and November 22, 2002, and as this occurred prior to the three year mark, there is no overlap. Thus, Applicants are entitled to a credit of 420 days for this delay.

Further with respect to 37 C.F.R. § 1.703(a)(2)-(4) and 35 U.S.C. § 154(b)(1)(A), the relevant dates are those dates where the Office took more than four months to mail an action or notice of allowance in response to a reply from the Applicants. In the instant case, this occurred twice. Amendment C was filed on November 19, 2004 and the Office did not respond with a final Office Action until June 2, 2005. This would amount to 75 days of PTA credit. Similarly, the mailing of an Ex Parte Quayle action on May 6, 2009 following Applicant's appeal brief filed on December 4, 2008 would also merit a credit of 33 days. The rules allow an adjustment counted from the day after the date that is four months from Applicants' reply and ending on the date of mailing either an action or notice of allowance, whichever occurs first. However, since the number of

days occur for events dated after July 28, 2003, they would overlap with time afforded under 35 U.S.C. § 154(b)(1)(B) and cannot be counted. Thus, the days are shown in the table below, but not credited to Applicants.

In conclusion, a summation of the aforementioned 420 and 2,458 days is 2,878 days of credit and is shown in the table below.

Table 1: Calculation of PTA CREDITS (in DAYS)			
<u>Applicants Action (Date)</u>	<u>USPTO Action (Date)</u>	<u>Days of Credit</u>	<u>Basis for Adjustment</u>
Application Filing (7/28/00)	Issue Date (4/20/10)	2,458	35 U.S.C. § 154(b)(1)(B) 37 C.F.R. § 1.703(b) Calc. from number of days between 7/28/03 and 4/20/10
Application Filing (7/28/00)	First Non-Final Office Action (11/22/02)	420	35 U.S.C. § 154(b)(1)(A) 37 C.F.R. § 1.704(a)(1), 37 C.F.R. § 1.703(a)(1), and 35 U.S.C. § 154(b)(1)(A)(i)(I)
Amendment C (11/19/04)	Final Office Action (6/2/05)	(75) no credit; overlap	35 U.S.C. § 154(b)(1)(A) 37 C.F.R. § 1.703(a)(2); 37 C.F.R. § 1.704(b)
Appeal Brief (12/4/08)	Ex Parte Quayle (5/7/09)	(33) no credit; overlap	35 U.S.C. § 154(b)(1)(A) 37 C.F.R. § 1.704(a)(4)
TOTAL CREDITS		2,878 days	

Dates Used in Calculating PTA Debits

The PTA calculated from the credits above, is reduced by a total of 1,189 days, thus entitling Applicants to a total PTA of 1,689 days.

The rules reduce the period of adjustment of the patent term when an applicant fails to engage in reasonable efforts to conclude prosecution of the application. An applicant shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application for the cumulative total of any periods of

time in excess of three (3) months that are taken to reply to any notice or action by the Office making any rejection, objection, argument or other request. (See 37 C.F.R. § 1.704(b)). This is also true with any supplemental paper, such as an Information Disclosure Statement (IDS) which is filed after an initial reply. (See 37 C.F.R. § 1.704(c)(8)). The following events summarized in the table below result in reduction in the PTA to which Applicants are entitled. For example, the first event follows a non-final Office Action that was mailed on April 28, 2003. Applicants did not respond with Amendment B until September 29, 2003. This is more than three months after the non-final Office Action was mailed. Therefore, the period of PTA is reduced by the number of days beginning on the day after the date that is three months after the date of mailing of the Office communication and ending on the date the reply was filed. Similarly, this occurred when Applicants filed Amendment C, a first Notice of Appeal, a Second Amendment B, a second Notice of Appeal, two IDS, and for payment of the issue fee. The total number of days resulting from Applicants' responses after the three month time periods, including the submission of supplemental papers is 643 days. Thus, the PTA credit calculated above shall be reduced by 643 days.

In the discussion above regarding the failure to issue a patent within three years from its filing date, Applicants note that the 2,458 days is reduced by 546 days. Under 37 C.F.R. § 1.703 (b)(4), the time can be reduced by the number of days between filing a notice of appeal and the mailing of an action or decision by the Board of Patent Appeals. In the instant case, three appeals were filed. A first appeal was filed on December 2, 2005; a second was filed on February 26, 2007; and a third on September 4, 2008. Subsequent actions were mailed on August 25, 2006; April 2, 2007; and May

7, 2009, respectively in response to each appeal brief. Thus, the total number of days between the multiple appeals and respective subsequent action is 546 days, by which the credits should be reduced.

In conclusion, Applicants respectfully submit that the total PTA calculation of 2,878 days should be reduced by 1,189 days shown by the table below, thereby entitling Applicants to a total PTA of 1,689 days.

Table 2: Calculation of PTA DEBITS (in Days)			
<u>USPTO Action (Date)</u>	<u>Applicants Action (Date)</u>	<u>Days of Debit</u>	<u>Basis for Adjustment</u>
Non-Final OA (4/28/03)	Amendment B (9/29/03)	63	37 C.F.R. § 1.704(b)
Non-Final OA (5/19/04)	Amendment C (11/19/04)	92	37 C.F.R. § 1.704(b)
	IDS (4/25/05 after Amendment C)	157	37 C.F.R. § 1.704(c)(8)
Final OA (6/2/05)	Notice of Appeal (12/2/05)	91	37 C.F.R. § 1.704(b)
Non-Final OA to Re-open Prosecution (8/25/06)	Notice of Appeal (2/26/07)	93	37 C.F.R. § 1.704(b)
Non-Final OA (9/20/07)	Amendment B (1/22/08)	33	37 C.F.R. § 1.704(b)
	IDS (3/12/08 after Amendment B)	50	37 C.F.R. § 1.704(c)(8)
Final OA (4/4/08)	Notice of Appeal (9/4/08)	62	37 C.F.R. § 1.704(b)
Notice of Allowance (7/24/09)	Payment of Issue Fee (10/26/09)	2	37 C.F.R. § 1.704(c)(3)
Reductions to 3 year Requirement under 37 C.F.R. § 1.703(b)			
Reopen Pros (5/7/09)	Notice of Appeal (9/4/08)	245	37 C.F.R. § 1.703(b)(4)
Reopen Pros (4/2/07)	Notice of Appeal (2/26/07)	35	37 C.F.R. § 1.703(b)(4)
Reopen Pros (8/25/06)	Notice of Appeal (12/2/05)	266	37 C.F.R. § 1.703(b)(4)
TOTAL DEBITS		1,189 days	

Terminal Disclaimer Not Applicable

An application for PTA must be accompanied by a statement of whether the patent is subject to a terminal disclaimer and any expiration date specified in the terminal disclaimer. (See 37 C.F.R. § 1.705(d)). As such, Applicants note that this application has not been subjected to a terminal disclaimer or any expiration date.

Relevant Circumstances under 35 C.F.R. § 1.704

As discussed above, Applicants responded to the Office Action outside of the three month time periods on nine events summarized below:

- (1) Replying with Amendment B on 9/29/2003 following a non-final Office Action mailed 4/28/2003.
- (2) Replying with Amendment C on 11/19/2004 following a non-final Office Action mailed 5/19/2004.
- (3) An IDS filed on 4/25/05 after Amendment C.
- (4) Replying with a first Notice of Appeal on 12/2/2005 following a final Office Action mailed on 6/2/2005.
- (5) Replying with a Notice of Appeal on 2/26/2007 following a non-final Office Action on 8/25/2006.
- (6) Replying with Amendment B on 1/22/2008 following a non-final Office Action mailed on 9/20/2007.
- (7) An IDS filed on 3/12/2008 after Amendment B.
- (8) Replying with a second Notice of Appeal on 9/4/2008 following a final Office Action dated 4/4/2008.
- (9) Paying the issue fee on 10/26/2009 after receiving a notice of allowance on 7/24/2009.

The dates of Applicants replies have been used in calculating the number of days by which the calculated PTA should be debited. Thus, Applicants are entitled to receive a total of 1,689 days of PTA.

CONCLUSION

In light of the above statement of the facts, it is respectfully submitted that the PTA please be reconsidered and adjusted accordingly.

DEPOSIT ACCOUNT

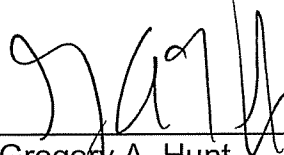
The Commissioner is hereby authorized to charge any fees associated with the filing of this correspondence to Deposit Account No. 50-0426.

Respectfully submitted,

JENKINS, WILSON, TAYLOR & HUNT, P.A.

Date: May 19, 2010

By:



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